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10/817,365	04/02/2004	Brian R. Lucas	B04-11	2573

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EXAMINER
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FIDEI, DAVID

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/817,365

**Applicant(s)**

LUCAS, BRIAN R.

**Examiner**

David T. Fidei

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bridgestone Sports Co. Ltd., Japanese Publication no. 2000-344284 (hereinafter Bridgestone). A package and plurality of golf balls is disclosed comprising an enclosure formed of a material comprising paper stock for printing thereon and a plurality of golf balls disposed therein, e.g., see the machine translated abstract. The enclosure comprises a top portion, bottom portion and a plurality of side portions joining the top and bottom portions held together by tabs 3 and folding. Paragraph [0007] of the MEANS translation section states the paper housing 1 is used for various alphabetic characters, a graphic form, etc.” provided in different regions of the housing.

As to claims 1, 4, 6, 10, 11 and 12, the particular type of images, words, letters, colors or graphics employed are of no patentable significance. Such particulars are considered printed matter having no specific functional relationship to the package because the printed matter does no depend on the package and package does not depend on the printed matter.<sup>1</sup> One can place any type of image, word, letters, colors or graphics desired thereon.

As to claims 2 and 3, the package mentioned above has top and bottom rectangular portions orientated substantially parallel to one another interconnected by four side portions.

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<sup>1</sup> In order to distinguish over the prior art there must be some functional relationship between the specific content of the printed matter to the apparatus employing the printed matter, i.e., the printed matter depends on the apparatus, and the apparatus depends on the printed matter. Although factually distinct, the *In re Ngai*, 70 USPQ2d 1862 (Fed. Cir. 2004) and *In re Gulack*, 217 USPQ 410 (Fed. Cir. 1983), held the same basic premise of “where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.

As to claims 5, 7-8 and 12, these claims relate to how the product is made, e.g., an image is scanned or downloaded from a website, transferred by pad printing, etc. These "product by process" type of limitations do not patentably distinguish the package, since it is immaterial from the final product package as to how the specific type of images, words, letters, colors or graphics are produced.<sup>2</sup>

As to claims 9, 13 and 14, it would have been an obvious matter of design choice to construct the package to hold 6 golf balls instead of five, and the ink layer of any reasonable thickness desired, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Also, it has been held that where the only difference between the prior art device and the claimed device was a recitation of relative dimensions, the claimed device was not patentably distinct from the prior art device, Gardner v. TED Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. Denied, 469 U.S. 830, 2325 USPQ 232 (1984), see M.P.E.P. 2144.04 (IV).

As to claim 15, to place the image on any portion of the enclosure, such as the top would have been obvious for the reason of providing easy viewing of the indicia image.

3. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bridgestone Sports Co. Ltd., Japanese Publication no. 2000-344284 (hereinafter Bridgestone) in view of Wang et al (U.S. Publication no. US 2002/0117405 A1). A package and plurality of golf balls is disclosed comprising an enclosure formed of a material comprising paper stock for printing thereon and a plurality of golf balls disposed therein, e.g., see the machine translated abstract. The enclosure comprises a top portion (a), bottom portion (b) and a plurality of side portions (A-

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<sup>2</sup> A "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17(footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Fessmann, 180 USPQ 324; In re Avery, 186 USPQ 161; In re Wertheim, 191 USPQ 90; and In re Marosi et al, 218 USPQ 289, all of which make it clear that it is the patentability of the final product per se which must be determined in a "product by process" claim, and the an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. During examination, the patentability of a product-by-

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D) joining the top and bottom portions held together by tabs 3 and folding. Paragraph [0007] of the MEANS section of the translation states the paper housing 1 is used for “various alphabetic characters, a graphic form, etc.” provided in different regions of the housing 1.

As to claim 1, the difference between the presently claimed golf ball package and Bridgestone resides in at least one of the top, bottom, or side portions comprise an image of an individuals business card. Wang et al (U.S. Publication no. US 2002/0117405 A1) teaches the printing of an image in figure 2 that is of an individuals business card, i.e., the printing carrier a person’s name ( Jones), their trade (Dr.) and a picture 23 of the doctor, see the last line of paragraph [0021]. To modify the package of Bridgestone by providing some portion of the housing with a business card image is fairly taught as recognized by Wang et al and would have been prima facie

As to claims 2-4, Bridgestone has a top and bottom interconnected by four side portions (A-D) as shown in figure 1a. Bridgestone also discloses information identifying the golf balls contained therein. Both trademark and golf ball property indicia 11 are disclosed in paragraphs [0016] & [0017] of the DETAILED DESCRIPITON machine translation. obvious for the reason of promoting an individual name, business or profession. 12, the particular type of images, words, letters, colors or graphics employed are of no patentable significance.

As to claims 5, 6, 10-12 such particulars are considered printed matter having no specific functional relationship to the package because the printed matter does no depend on the package and package does not depend on the printed matter. One can place any type of image, word, letters, ink, colors or graphics desired thereon.<sup>3</sup>

As to claims 5, 7-8, 12 these claims relate to how the product is made, e.g., an image is scanned or downloaded from a website, transferred by pad printing, etc. These “product by process” type of limitations do not patentably distinguish the package, since it is immaterial from the final product package as to how the specific type of images, words, letters, colors or graphics are produced.<sup>4</sup>

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process claim is determined by the novelty and non-obviousness of the claimed product itself without consideration of the process for making it that is recited in the claim. In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

<sup>3</sup> See footnote 1.

<sup>4</sup> See footnote 2.

As to claims 9, 13 and 14, it would have been an obvious matter of design choice to construct the package to hold 6 golf balls instead of five, and the ink layer of any reasonable thickness desired, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Also, it has been held that where the only difference between the prior art device and the claimed device was a recitation of relative dimensions, the claimed device was not patentably distinct from the prior art device, Gardner v. TED Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. Denied, 469 U.S. 830, 2325 USPQ 232 (1984), see M.P.E.P. 2144.04 (IV).

As to claim 15, to place the image on any portion of the enclosure, such as the top would have been obvious for the reason of providing easy viewing of the indicia image.

4. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1-15 above, and further in view of Admitted Prior Art, page 9, lines 3-12 of the present specification (Admission). The difference between these claims and the prior art of Bridgestone Sports Co. Ltd., Japanese Publication no. 2000-344284 (hereinafter Bridgestone) and Wang et al (U.S. Publication no. US 2002/0117405 A1) as applied above resides in a finishing layer, claim 16. Claim 20 merely reciting a clearcoat.

Claim 17 reciting wherein the finishing layer comprises a clearcoat, a UV curable clearcoat a hot laminate, a cold inanimate, a UV-resistant laminate, a dry erase laminate, or a non-skid laminate.

Claim 18 reciting a package and plurality of golf balls of claim 17, wherein the finishing layer comprises a UV-curable clearcoat.

Claim 19 reciting the package and plurality of golf balls of claim 17, wherein the finishing layer has a thickness of from 1 mil to 10 mil.

However, the specification page 9, lines 3-12 contains an admission where this subject matter was known prior to the present invention. Particularly where Odyssey's new AquaSeal Liquid Laminator provided the newest technology with a coating up to 1.2 mils thick. It would have been obvious to one of ordinary skill in the art to provide a clearcoat as a character as

claimed in view of Admission, in order to prevent the printed package from marring or scratching.

***Response to Arguments***

5. Applicant's arguments filed November 18, 2005 have been fully considered but they are not persuasive in view of the newly added art necessitated by applicant changes made to the claims.

The clarification of claim 6 along with applicants research of the M.P.E.P. is persuasive in defining the terminology scope. That coupled with applicant's remarks on page 5 of 8 of the response makes the prior rejection of indefiniteness for reciting a Trademark moot.

Regarding the amended subject matter, the use of paper boxes for packaging golf balls is well known and conventional. While the prior rejection employed a document which used a polymer material, Japanese Publication no. 2000-344284 by Bridgestone Sports Co. Ltd. cited by applicant. The housing 1 as shown in figure 1a is in "blank" form as would be recognized by one skilled in the art. Also, the device is made of one single paper piece, rather than several, resulting in what Bridgestone characterizes as a saving of paper. Furthermore, Bridgestone provides a showing of paper housing with indicia provided thereon as noted above. Furthermore, Bridgestone does not teach away from the present invention in that reduction of packaging cost is addressed.

As to the notion that there must be some piece of prior art to suggest or teach all of the claim limitations, the Examiner respectfully disagrees. It is well settled the rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine , 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), see M.P.E.P. §2144.

In the present instance, the use of a known golf ball package to carry an image of a business card merely represents a different use of a known product. Particularly, where the business card image has no functional relationship to the golf balls or package carrying the golf

balls. As such it is believed the references to *In re Ngai*, 70 USPQ2d 1862 (Fed. Cir. 2004) and *In re Gulack*, 217 USPQ 410 (Fed. Cir. 1983) are pertinent to the present subject matter in that “where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability”. Otherwise all one would have to do is merely provide different indicia to obtain seemingly endless patents on new uses for an existing product.

Accordingly, it is submitted present invention is not patentable over the prior art for these reasons.

6. As to the newly added claims differences are described that go beyond mere “printed matter”. However, addressed above these differences are not novel. The use of a clearcoat finishing layer is admitted prior art. Also, cited herein are further documentation showing the use of a protective transparent finishing layer over indicia, see Robinson Patent no. 3,452,464, col. 3, lines 55-58 and Cooper U.S. Patent Application no. US 2004/0238096 A1 layer 18. To provide the known golf ball boxes with such a layer would have been obvious at the time of the invention for the aforementioned reason.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



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8. Any inquiry concerning this communication or earlier communications from the Examiner concerning the merits of the claims should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David T. Fidei  
Primary Examiner  
Art Unit 3728

dtf  
August 8, 2005